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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT: Wyatt

EXAMINER: Pass

SERIAL NO.: 09/544,509

GROUP ART UNIT: 3626

FILING DATE: April 6, 2000

ATTY. DOCKET NO.:MCO-P-00-003

INVENTION: "A METHOD AND SYSTEM FOR MATCHING MEDICAL CONDITION INFORMATION WITH A MEDICAL RESOURCE ON A COMPUTER NETWORK"

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Commissioner for Patents
P.O. Box 1450
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APPELLANT'S APPEAL BRIEF

MADAM:

This Appeal Brief is submitted in support of the Notice of Appeal filed on May 26, 2006. The Appeal was taken from the Final Rejection dated April 4, 2006.

I. REAL PARTY IN INTEREST

Medical Central Online is the real party in interest as the assignee of this application.

II. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellant or Appellant's legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

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III. STATUS OF CLAIMS

Claims 1-20 are pending in this patent application. A copy of the claims is appended hereto as the Appendix. Claims 1-20 were finally rejected by the Examiner in a Final Rejection dated April 4, 2006 and are hereby on appeal. The Final Rejection is appended hereto as Exhibit A of the Supplemental Appendix.

IV. STATUS OF AMENDMENTS

All amendments have been entered in this patent application. No amendments to the claims were made after the Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention relates to a method and a system for matching medical condition information with a medical resource. Additionally, the present invention relates to a method and a system for matching medical condition information such as, for example, diseases, disorders and/or medical procedures related thereto, with a medical resource, such as, for example, specialists, specialty hospitals, and/or any other medical resource. Further, the present invention relates to a method and a system for matching medical condition information with a medical resource contained on a computer network. Page 7, lines 17-28.

Independent Claim 1 defines a method for matching medical condition information with a medical resource. Claim 1 requires providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a

website. Further, Claim 1 requires accessing the website via an individual remote computer on the computer network. Still further, Claim 1 requires inputting a query into the website wherein the query relates to a first medical condition. Page 8, lines 8-18 and 28-35; and page 9, lines 11-28.

Moreover, Claim 1 requires providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which at least one of the plurality of medical conditions. Page 9, lines 15-28; page 10, lines 4-16; and page 11, lines 4-9.

Furthermore, Claim 1 requires searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource. In addition, Claim 1 requires displaying third information via the individual remote computer wherein the third information relates to

the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query. Page 11, lines 9-22.

Independent Claim 15 defines a system for matching a medical condition with a medical resource. Claim 15 requires a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website. Further, Claim 15 requires a database connected to the remote server wherein the database stores first information relating to a plurality of medical conditions and a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions. Still further, Claim 15 requires means for inputting a query wherein the query relates to one of the plurality of medical conditions. Page 9, lines 15-28; page 10, lines 4-16; and page 11, lines 4-9.

Moreover, Claim 15 requires means for searching the first information in the database based on the query wherein the means for searching matches a medical resource from the plurality of medical resources to the query wherein the medical resource treats one of the plurality of medical conditions of the query. Furthermore, Claim 15 requires means for disclosing second

information wherein the second information relates to one of the plurality of medical conditions of the query. Page 11, lines 9-22. In addition, Claim 15 requires means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource. Page 12, lines 5-18.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Do Claims 1-20 contain subject matter, under 35 U.S.C. §112, first paragraph, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention?
2. Is Claim 1 indefinite, under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claims the subject matter which Appellant regards as the invention?
3. Would Claims 1-20 have been obvious under 35 U.S.C. §103(a) to one having ordinary skill in the art at the time of Appellant's invention over Business Wire article "Specialty Care Network Announces Internet Strategy; New Healthgrades.com Site to Office Provider and Health Plan Rating Information" (hereinafter "Healthgrades") in view of Applicant's Admissions in the "Background of the Specification" (hereinafter "AAPA")? See *Healthgrades* attached as Exhibit B of the Supplemental Appendix.

VII. ARGUMENT

A. THE REJECTION OF CLAIMS 1-20 UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 1-20 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

In the Final Rejection, the Examiner stated:

Independent Claims 1, 15 recite limitation that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows: 'wherein the medical condition of the query is matched to a second medical condition' as disclosed in Claim 1 at lines 21-22; 'wherein the third information relates to the second medical condition' at lines 30-31; 'means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query' in Claim 15 at lines 24-26.

(See Final Rejection, page 3 of Exhibit A of the Supplemental Appendix.)

B. CLAIMS 1-20 CONTAIN SUBJECT MATTER WHICH WAS DESCRIBED IN THE SPECIFICATION IN SUCH A WAY AS TO REASONABLY CONVEY TO ONE SKILLED IN THE RELEVANT ART THAT THE INVENTOR, AT THE TIME THE APPLICATION WAS FILED, HAD POSSESSION OF THE CLAIMED INVENTION

With respect to the rejection of Claims 1-20 under 35 U.S.C. §112, first paragraph, Appellant asserts that Claims 1-20 are described in the specification in such a way as to convey to one skilled in the relevant art that Appellant, at the time the

application was filed, had possession of the claimed subject matter.

The Examiner alleges that the specification does not disclose that the medical condition of the query is matched to a second medical condition or that the third information relates to the second medical condition, respectively, as required by Claim 1. Appellant asserts that the specification states that "an individual may choose or otherwise enter a particular medical condition via step 56." Page 9, lines 23-25. Further, the specification discloses that "[t]he particular medical conditions may be stored within the databases 18,20, or any other database." Page 10, lines 18-21. Still further, the specification discloses that "[a]fter an individual has chosen a particular medical condition or a medical procedure via steps 56 or 58, respectively, the individual may search the database 18,20 via a step 66." Page 11, lines 17-21. Moreover, the specification discloses that "[t]he search of the database 66 may match the medical resources with the particular medical conditions and/or medical procedures chosen by the individual." Page 11, lines 25-28. Therefore, Appellant submits that the specification discloses that the medical condition of the query is matched to a second medical condition or that the third information relates to the second medical condition, respectively, as required by Claim 1.

Furthermore, the Examiner alleges that "means for disclosing second information wherein the second information relates to one of

the plurality of medical conditions of the query" as required by Claim 15 is not disclosed in the specification. On the contrary, the specification discloses:

The particular medical conditions may be stored within the databases 18,20, or any other database, and may include information on the diseases 60 and/or the disorders 62. For example, the diseases 60 and/or the disorders 62 may be taken from, or otherwise derived from, the International Code of Diseases (ICD) published by the World Health Organization. Specifically, the diseases 60 and/or the disorders 62 may be taken from ICD-9 or ICD-10 lists or may be taken from SnoMed™. However, any disease or other disorder nomenclature presently known or subsequently developed may be used, and the present invention should not be limited as herein described.

Page 10, lines 17-30. Therefore, Appellant asserts that means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query as required by Claim 15 is disclosed in the specification in such a manner in such a way as to reasonably convey to one skilled in the relevant art that the Appellant was in possession of the claimed subject matter at the time the application was filed. Accordingly, Appellant asserts that the rejection of Claims 1-20 under 35 U.S.C. §112, first paragraph, is improper and should be reversed.

C. THE REJECTION OF CLAIM 1
UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards

as the invention.

In the Final Rejection, the Examiner stated:

Claim 1 recites "matched to a second medical condition from the plurality of medical resources in the first information" on lines 22-23. However, the "first information" as defined in Claim 1 relates to "a plurality of medical conditions," not a plurality of medical "resources." For the purposes of applying art, Examiner assumes the limitation to read "matched to a second medical condition from the plurality of medical conditions in the first information."

(See Final Rejection, page 4 of Exhibit A of the Supplemental Appendix.)

D. CLAIM 1 IS NOT INDEFINITE FOR FAILING TO PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE SUBJECT MATTER WHICH APPELLANT REGARDS AS THE INVENTION

With respect to the rejection of Claim 1 under 35 U.S.C. §112, second paragraph, Appellant asserts that Claim 1 is not indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

The Examiner alleges that the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information as required by Claim 1 is indefinite. Claim 1 requires that the first information relates to a plurality of medical conditions and that the second information relating to a plurality of medical resources. In other words, a second medical condition in the first information is matched from the plurality of medical resources. Therefore, Claim

1 is not indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Accordingly, the rejection of Claim 1 is improper and should be reversed.

**E. THE CITED REFERENCES AND REJECTION OF CLAIMS 1-20
UNDER 35 U.S.C. §103(a)**

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Healthgrades* in view of AAPA.

In the Final Rejection, the Examiner stated:

Healthgrades and AAPA teach a method as analyzed and discussed in the previous Office Action (paper number 09072005) wherein the database (AAPA; page 1, lines 21-29) stores first information relating to a plurality of medical conditions (*Healthgrades*; paragraph 5) and second information relating to a plurality of medical resources (*Healthgrades*; paragraph 5) wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, speciality hospitals, medical facilities and health facilities which at least one of the plurality of medical conditions [sic]; Examiner interprets *Healthgrades* teachings of "only regarding the best hospitals and physicians to treat their illness" (*Healthgrades*; paragraph 5) as teach storing of Applicant's "first information" and "second information;"

searching the first information and the second information in the database (AAPA; page 1, line 21 to page 2, line 6) based on the query input into the website (*Healthgrades*; paragraph 5) wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query (*Healthgrades*; paragraphs 4-5) wherein the

medical condition of the query is treatable by the medical resource; Examiner interprets *Healthgrades* teachings of "[f]irst, they want to know about the disease and the appropriate procedure to treat the disease. Second, they want to know where and to whom to go for the best care. Many sites provide information on the former" (*Healthgrades*; paragraph 4) and "Consumer sites such as AOL.com's Health & Fitness Channel...provide valuable disease and condition information to consumers" (*Healthgrades*; paragraph 5) as teaching inputting queries into a website wherein medical conditions in the query are matched to stored medical conditions in the "first information;" and Examiner interprets *Healthgrades* teachings of "only through *Healthgrades.com* or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (*Healthgrades*; paragraph 5) as teaching "wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources;" and

displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query; Examiner interprets a "Web site" that is a "portal for consumers" (*Healthgrades*; paragraph 5) and a "Web-based site for the distribution of free health care provider...[...]...information" (paragraph 2) and that enables "consumers [to] find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (*Healthgrades*; paragraph 5) as teaching this limitation.

(See Final Rejection, page 6 of Exhibit A of the Supplemental Appendix.)

F. CLAIMS 1-20 WOULD NOT HAVE BEEN OBVIOUS TO ONE OF ORDINARY SKILL IN THE ART AT THE TIME OF APPELLANT'S INVENTION OVER HEALTHGRADES IN VIEW OF AAPA

With respect to the under 35 U.S.C. §103(a) as being unpatentable over *Healthgrades* in view of AAPA, Appellant respectfully submits that the claims distinctly define the present invention from *Healthgrades* and AAPA, taken singly or in combination, for the reasons that follow.

Independent Claim 1 requires a method for matching medical condition information with a medical resource having the step of providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources. Further, Claim 1 requires that the plurality of medical conditions are diseases and disorders and the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions. Still further, Claim 1 requires the step of searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource. Moreover, Claim 1

requires the step of displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query.

Independent Claim 15 requires a system for matching a medical condition with a medical resource having a database connected to the remote server wherein the database stores first information relating to a plurality of medical conditions and a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions. Further, Claim 15 requires means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query. Moreover, Claim 15 requires means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource.

Healthgrades merely teaches that HealthGrades.com intends to be the leading web-based site for the distribution of free health care provider and health plan rating information. Further, *Healthgrades* teaches that HealthGrades.com is designed to provide straightforward and objective educational quality ratings in the form of "report card" information. The information is based on

conclusions derived from applying complex and proprietary company-developed algorithms to collected provider data.

Contrary to the assertions of the Patent Office, AAPA merely disclose deficiencies and problems in the art which are addressed by the present invention. The deficiencies and problems in the art as set forth in the AAPA are overcome by the present invention.

Neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the step of providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions as required by Claim 1.

Further, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the step of searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information as required by Claim 1.

Still further, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests that a medical resource from

the plurality of medical resources in the second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource as required by Claim 1.

Moreover, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the step of displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query as required by Claim 1.

With respect to Claim 15, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests a database connected to the remote server wherein the database stores first information relating to a plurality of medical conditions and a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions as required by Claim 15.

Further, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query as required by Claim 15. Still further, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests means for contacting the

medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource as required by Claim 15.

On the contrary, *Healthgrades* merely teaches that "we intend to make HealthGrades.com the leading web-based site for the distribution of free health care provider and health plan rating information." Further, *Healthgrades* teaches that "HealthGrades.com is designed to provide straightforward and objective educational quality ratings in the form of "report card" information." Still further, *Healthgrades* teaches "many sites provide information on the former, but only HealthGrades.com will provide information on the latter." Moreover, *Healthgrades* teaches "HealthGrades.com, Inc. currently offers Hospital Report Cards (at www.healthcarereportcards.com), which rates virtually every U.S. hospital based on specific performance in the areas of cardiac, orthopaedic, neuroscience, pulmonary/respiratory and vascular care.

As set forth above, the Patent Office asserts in the Office Action that the Examiner interprets *Healthgrades'* teaching of providing a web site where "consumers find objective data regarding the best hospital and physicians to treat their illness" as reading on the step of searching the database for information wherein the search or request is based on the query or search request input into the database and further wherein the search discloses a medical resource that treats the medical condition. However, Appellant asserts that the interpretation of *Healthgrades* by the

Examiner is incorrect in view of paragraph 5 of *Healthgrades* which states "HealthGrades.com will include two new report card products for physicians and health plans, as well as an expanded version of its Hospital Report Card product that includes obstetrics and pediatrics." Moreover, Appellant asserts that the Examiner errs in relying on an interpretation and has not provided a specific teaching in any reference.

Further, as set forth above, *Healthgrades* teaches that "HealthGrades.com, Inc. currently offers Hospital Report Cards (at www.healthcarereportcards.com), which rates virtually every U.S. hospital based on specific performance in the areas of cardiac, orthopaedic, neuroscience, pulmonary/respiratory and vascular care." Accordingly, Appellant asserts that *Healthgrades* teaches that the "objective data regarding the best hospitals and physicians to treat their illness" is merely the Hospital Report Cards which are based on specific performances in the areas of cardiac, orthopaedic, neuroscience, pulmonary/respiratory, vascular care, obstetrics and pediatrics.

AAPA merely disclose the deficiencies and the problems in the art prior to the present invention. Moreover, AAPA provides absolutely no teachings, references or even inferences that what was known prior to filing this application could have possible been combined or otherwise modified by any reference or teaching. The Examiner is simply overstretching and misapplying a teaching or combination which clearly does not exist. Nowhere does AAPA

disclose novel steps and structural elements required by Claims 1 and 15, respectively. Therefore, neither *HealthGrades* nor AAPA, taken singly or in combination, teaches or suggests the novel steps of the method for matching medical condition information with a medical resource as required by Claim 1. Moreover, neither *HealthGrades* nor AAPA, taken singly or in combination, teaches or suggests the structural elements of the system for matching a medical condition with a medical resource as required by Claim 15.

Further, Appellant asserts that one of ordinary skill in the art at the time of Appellant's invention would never have been motivated to combine *HealthGrades* with AAPA in the manner suggested by the Patent Office in formulating the rejections under 35 U.S.C. §103(a). As set forth above, AAPA merely disclose the deficiencies and the problems in the art prior to the present invention. It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v.

Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Appellant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Healthgrades* and AAPA in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Healthgrades* with the deficiencies and problems in the art as set forth in AAPA to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103.

Even assuming that one having ordinary skill in the art could somehow have combined the references applied by the Patent Office, the references still lack the novel steps and the structural elements positively recited in Claims 1 and 15, respectively.

Claim 3 requires that the medical conditions relate to diseases. Claim 4 require providing medical procedure information to one of the computers. Claim 5 requires searching the database for medical procedure information. Claim 6 requires disclosing on one of the remote computers a practitioner that treats the medical condition of the query.

Neither *Healthgrades* nor AAPA, taken singly or in combination,

teaches or suggests that the medical conditions relate to diseases as required by Claim 3. Further, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests providing medical procedure information to one of the computers as required by Claim 4. Still further, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests searching the database for medical procedure information as required by Claim 5. Moreover, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests disclosing on one of the remote computers a practitioner that treats the medical condition of the query as required by Claim 6.

AAPA merely disclose the deficiencies and the problems in the art prior to the present invention. *Healthgrades* merely teaches that "consumers [can] find objective data regarding the best hospitals and physicians to treat their illness." Therefore, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the present invention as defined by Claims 3-6.

Claim 8 requires disclosing medical resource information relating to the medical resource wherein the medical resource information includes a name of the medical resource, a location, contact information and services offered. Neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests disclosing medical resource information relating to the medical resource wherein the medical resource information includes a name of the medical resource, a location, contact information and

services offered as required by Claim 8. AAPA merely disclose the deficiencies and the problems in the art prior to the present invention. *Healthgrades* merely teaches that consumers "want to know where and to whom to go for the best care." Therefore, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the present invention as defined by Claims 3-6.

Claim 11 requires that the query includes identifying information of an individual using the website wherein the third information discloses one of the plurality of medical resources which matches the identifying information. Neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests that the query includes identifying information of an individual using the website wherein the third information discloses one of the plurality of medical resources which matches the identifying information as required by Claim 11. AAPA merely disclose the deficiencies and the problems in the art prior to the present invention. *Healthgrades* merely teaches that "Healthgrades.com will include two new report card products for physicians and health plans." Therefore, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the present invention as defined by Claim 11.

Claim 14 requires searching the database for the third information. Neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests searching the database for the third information as required by Claim 14. AAPA merely disclose the deficiencies and the problems in the art prior to the present

invention. *Healthgrades* merely teaches consumers can find "objective data regarding the best hospitals and physicians to treat their illness. Therefore, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the present invention as defined by Claim 14.

Claim 18 requires that the first information relating to the medical conditions further relates to medical procedures. Claim 19 requires that the first information relates to practitioners that treat one of the plurality of medical conditions of the query. Neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests that the first information relating to the medical conditions further relates to medical procedures as required by Claim 18. Further, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests that the first information relates to practitioners that treat one of the plurality of medical conditions of the query. AAPA merely disclose the deficiencies and the problems in the art prior to the present invention. *Healthgrades* merely teaches a website where consumers find data regarding physicians and hospitals. Therefore, neither *Healthgrades* nor AAPA, taken singly or in combination, teaches or suggests the present invention as defined by Claims 18 and 19.

Appellants further submit that absolutely no teaching, suggestion and/or incentive exists in *Healthgrades* to combine *Healthgrades* with AAPA. Therefore, the rejection of Claims 1-20 under 35 U.S.C. §103(a) is improper and should be reversed.

CONCLUSION

For the foregoing reasons, Appellant respectfully submits that the rejection of Claims 1-20 is erroneous as a matter of law and fact and respectfully requests the Board to reverse the rejection.

Respectfully submitted,


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IX. TABLE OF CONTENTS

1) APPENDIX: Claims 1-20

2) SUPPLEMENTAL APPENDIX

EXHIBIT A: Final Rejection

EXHIBIT B: *Healthgrades*

3) EVIDENCE APPENDIX

NONE

4) RELATED PROCEEDINGS APPENDIX

NONE

APPENDIX

Claim 1: A method for matching medical condition information with a medical resource, the method comprising the steps of:

providing a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website;

accessing the website via an individual remote computer on the computer network;

inputting a query into the website wherein the query relates to a first medical condition;

providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which at least one of the plurality of medical conditions;

searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource; and

displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query.

Claim 2: The method of Claim 1 further comprising the step of:

outputting the third information to the individual remote computer.

Claim 3: The method of Claim 1 wherein the medical conditions relate to diseases.

Claim 4: The method of Claim 1 further comprising the step of:

providing medical procedure information to one of the computers.

Claim 5: The method of Claim 1 further comprising the step of:

searching the database for medical procedure information.

Claim 6: The method of Claim 1 further comprising the step of:

disclosing on one of the remote computers a practitioner that treats the medical condition of the query.

Claim 7: The method of Claim 1 further comprising the step of:

disclosing a medical facility to the individual remote computer wherein the medical facility treats the medical condition of the query.

Claim 8: The method of Claim 1 further comprising the step of:

disclosing medical resource information relating to the medical resource wherein the medical resource information includes a name of the medical resource, a location, contact information and services offered.

Claim 9: The method of Claim 1 further comprising the step of:
linking one of the remote computers to a specific website
relating to the medical resource.

Claim 10: The method of Claim 1 wherein the third information
discloses more than one medical resource from the plurality of
medical resources that treat the medical condition of the query.

Claim 11: The method of Claim 1 wherein the query includes
identifying information of an individual using the website wherein
the third information discloses one of the plurality of medical
resources which matches the identifying information.

Claim 12: The method of Claim 1 further comprising the step of:
disclosing medical resources from the plurality of medical
resources that treat the medical condition of the query; and
ranking the medical resources based on how the medical
resources match the query.

Claim 13: The method of Claim 1 further comprising the step of:
providing a plurality of websites on the computer network;
accessing any one of the plurality of websites via the remote
computer; and
searching the database via any one of the plurality of
websites.

Claim 14: The method of Claim 1 further comprising the step of:
providing a plurality of databases on a plurality of remote
servers wherein the databases store the first information relating
to the plurality of medical conditions;
linking the databases via the computer network; and
searching the databases for the third information.

Claim 15: A system for matching a medical condition with a medical resource, the system comprising:

a computer network having a plurality of remote computers and at least one remote server wherein the remote server hosts a website;

a database connected to the remote server wherein the database stores first information relating to a plurality of medical conditions and a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which treat at least one of the plurality of medical conditions;

means for inputting a query wherein the query relates to one of the plurality of medical conditions; and

means for searching the first information in the database based on the query wherein the means for searching matches a medical resource from the plurality of medical resources to the query wherein the medical resource treats one of the plurality of medical conditions of the query;

means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query; and

means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource.

Claim 16: The system of Claim 15 further comprising:

means for outputting the second information from an individual remote computer.

Claim 17: The system of Claim 15 wherein the medical conditions relate to diseases.

Claim 18: The system of Claim 15 wherein the first information relating to the medical conditions further relates to medical procedures.

Claim 19: The system of Claim 15 wherein the first information relates to practitioners that treat one of the plurality of medical conditions of the query.

Claim 20: The system of Claim 15 further comprising:

a link on the website wherein the link links one of the remote computers to another website providing third information relating to the medical resource.

EVIDENCE APPENDIX

NONE

RELATED PROCEEDINGS APPENDIX

NONE

SUPPLEMENTAL APPENDIX



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,509	04/06/2000	Phil Wyatt	MCO-P-00-003	9084
29013	7590	04/04/2006	EXAMINER	
PATENTS+TMS, P.C. 2849 W. ARMITAGE AVE. CHICAGO, IL 60647			PASS, NATALIE	
		ART UNIT	PAPER NUMBER	
		3626		
DATE MAILED: 04/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/544,509	WYATT, PHIL	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 17 January 2006. Claims 1-2, 6-8, 10-12, 14-16, 18-20 have been amended. Claims 1-20 remain pending.

Claim Objections

2. Claim 1 is objected to because of the following informalities: Claim 1 recites “which at least one of the plurality of medical conditions” in lines 17-18. For the purpose of applying art, Examiner assumes this limitation to recite “which treat at least one of the plurality of medical conditions.” Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Newly amended claims 1-2, 6-8, 10-12, 14-16, 18-20 and claims 3-5, 9, 13, and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Independent claims 1, 15 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "wherein the medical condition of the query is matched to a second medical condition" as disclosed in claim 1 at lines 21-22;
- "wherein the third information relates to the second medical condition" at lines 30-31;
- "means for disclosing second information wherein the second information relates to one of the plurality of medical conditions of the query" in claim 15 at lines 24-26.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 6 April 2000. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B) Claims 2-14, 15-20 incorporate the features of independent claims 1, and 15, through dependency, and are also rejected.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 6 April 2000.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 1 recites “matched to a second medical condition from the plurality of medical resources in the first information” on lines 22-23. However the “first information” as defined in claim 1 relates to “a plurality of medical conditions,” not a plurality of medical “resources.” For the purpose of applying art, Examiner assumes the limitation to read “matched to a second medical condition from the plurality of medical conditions in the first information.” Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in amendment filed 17 January 2006 are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter concerns and 112, 1st rejections made in the sections above in the next communication sent in response to the present Office Action.

9. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Business Wire article "Specialty care Network Announces Internet Strategy; New HealthGrades.com Site to Offer Provider and Health Plan Rating Information." June 30, 1999, Business wire, p1519, hereinafter known as HealthGrades, in view of Applicant's admissions in the "Background of the Specification" section of the Specification, (hereinafter known as "AAPA"), for substantially the same reasons given in the previous Office Action (paper number 09072005). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to recite

- "second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which at least one of the plurality of medical conditions" in lines 13-18;
- "searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is

matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource” in lines 19-27; and

- “displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query” in lines 29-33.

As per these new limitations, HealthGrades and AAPA teach a method as analyzed and discussed in the previous Office Action (paper number 09072005)

wherein the database (AAPA; page 1, lines 21-29) stores first information relating to a plurality of medical conditions (HealthGrades; paragraph 5) and second information relating to a plurality of medical resources (HealthGrades; paragraph 5) wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which at least one of the plurality of medical conditions; Examiner interprets HealthGrades teachings of “only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness” (HealthGrades; paragraph 5) as teaching storing of Applicant’s “first information” and “second information;”

searching the first information and the second information in the database (AAPA; page 1, line 21 to page 2, line 6) based on the query input into the website (HealthGrades; paragraph 5) wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource from the plurality of medical resources in the second information is matched to the medical condition of

the query (HealthGrades; paragraphs 4-5) wherein the medical condition of the query is treatable by the medical resource; Examiner interprets HealthGrades teachings of “[f]irst, they want to know about the disease and the appropriate procedure to treat the disease. Second, they want to know where and to whom to go to for the best care. Many sites provide information on the former” (HealthGrades; paragraph 4) and “Consumer sites such as AOL.com's Health & Fitness Channel (NYSE:AOL), drkoop.com (Nasdaq:KOOP), iVillage's BetterHealth.com (Nasdaq:IVIL), Yahoo!'s Health channel (Nasdaq:YHOO), MSN's Health channel (Nasdaq:MSFT), Onhealth (Nasdaq:ONHN), Mediconsult (Nasdaq:MDCS), Healtheon's WebMD(Nasdaq:HLTH), and adam.com (Nasdaq:ADAM) provide valuable disease and condition information to consumers” (HealthGrades; paragraph 5) as teaching inputting queries into a website wherein medical conditions in the query are matched to stored medical conditions in the “first information;” and Examiner interprets HealthGrades teachings of “only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness” (emphasis added) (HealthGrades; paragraph 5) as teaching “wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources;” and displaying third information via the individual remote computer wherein the third information relates to the second medical condition and further wherein the third information relates to the medical resource which matches the medical condition of the query; Examiner interprets a “Web site” that is a “portal for consumers” (HealthGrades; paragraph 5) and a “Web-based site for the distribution of free health care provider … [...] … information” (paragraph 2) and that enables “consumers [to] find objective data regarding the best hospitals

and physicians to treat their illness" (emphasis added) (HealthGrades; paragraph 5) as teaching this limitation.

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 09072005, section 4, pages 3-4), and incorporated herein.

The motivations for combining the respective teachings of HealthGrades and AAPA are as given in the rejection of claim 1 in the previous Office Action (paper number 09072005), and incorporated herein.

(B) Claim 15 differs from method claim 1 in that it recites a system rather than a method for matching medical condition information with a medical resource.

Claim 15 has been amended to recite

- "means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource" in lines 25-27.

As per this new limitation, HealthGrades and AAPA teach a system as analyzed and discussed in the previous Office Action (paper number 09072005) further comprising means for contacting the medical resource on the website wherein the medical resource is contactable from the website via the means for contacting the medical resource (HealthGrades; paragraph 6); Examiner interprets HealthGrades teachings of "[t]he site will contain over 20 solution-based content areas, providing online and downloadable forms, templates, tools, communications resources (e-mail and message boards) and more" as teaching this limitation.

The remainder of amended system claim 15 repeats the subject matter of amended claim 1, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the teachings of HealthGrades and AAPA in the above rejection of claim 1, it is readily apparent that the system disclosed by HealthGrades and AAPA includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

The motivations for combining the respective teachings of HealthGrades and AAPA are as given in the rejection of claim 1 in the previous Office Action (paper number 09072005), and incorporated herein.

(C) The amendment to claims 2, 6-8, 10-12, 14, 16, 18-20 appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 09072005, section 4, pages 3-4), and incorporated herein.

(D) Claims 3-5, 9, 13, and 17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 09072005, section 4, pages 4-7), and incorporated herein.

Response to Arguments

10. Applicant's arguments filed 17 January 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 17 January 2006.

(A) At pages 12-19 of the 17 January 2006 amendment, Applicant argues that the limitations of claims 1-20 are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied reference, including the newly added limitations, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the teachings of HealthGrades and AAPA, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 09072005), and incorporated herein. In particular, Examiner notes that "providing a database on the remote server wherein the database stores first information relating to a plurality of medical conditions and second information relating to a plurality of medical resources wherein the plurality of medical conditions are diseases and disorders and further wherein the plurality of medical resources are medical specialists, specialty hospitals, medical facilities and health facilities which at least one of the plurality of medical conditions" and "searching the first information and the second information in the database based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources in the first information wherein a medical resource form the plurality of medical resources in the

second information is matched to the medical condition of the query wherein the medical condition of the query is treatable by the medical resource" as recited in claims 1 and 15, are taught by the cited references. In particular, please note that AAPA teaches databases that store information on medical diseases and that are located on remote servers (AAPA; page 1, line 21 to page 2, line 6); (Examiner interprets AAPA's teaching of "[i]t is, of course, generally known to provide information on a computer network. Generally, the computer network may consist of one or a plurality of remote servers that may host one or more websites that may allow an individual to access a database. The database may contain the information in an organized manner so that an individual on a remote computer may access the website and search the database for particular information ... [...] ... Further, it is also generally known to provide access to databases that may contain medical information such as, for example, diseases, disorders or medical procedures" (AAPA; page 1, line 21 to page 2, line 6) as reading on this limitation); and note that HealthGrades teaches storing information regarding medical resources such as hospitals and physicians remotely (HealthGrades; paragraph 5); (Examiner interprets HealthGrades teachings of "only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness" (HealthGrades; paragraph 5) as teaching remote storing of a plurality of medical resource information and remote storing of a plurality of disease or "illness" information). In addition, Examiner interprets HealthGrades teachings of "[f]irst, they want to know about the disease and the appropriate procedure to treat the disease. Second, they want to know where and to whom to go to for the best care. Many sites provide information on the former" (HealthGrades; paragraph 4) and "Consumer sites such as AOL.com's Health & Fitness Channel

(NYSE:AOL),drkoop.com (Nasdaq:KOOP), iVillage's BetterHealth.com(Nasdaq:IVIL),Yahoo!'s Health channel (Nasdaq:YHOO), MSN's Health channel (Nasdaq:MSFT),Onhealth (Nasdaq:ONHN), Mediconsult (Nasdaq:MDCS), Healtheon's WebMD(Nasdaq:HLTH), and adam.com (Nasdaq:ADAM) provide valuable disease and condition information to consumers" (HealthGrades; paragraph 5) as teaching inputting queries into a website wherein medical conditions in the query are matched to stored medical conditions in the "first information," and Examiner interprets HealthGrades teachings of "only through HealthGrades.com or through one of its partner sites can consumers find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (HealthGrades; paragraph 5) as teaching "searching ... based on the query input into the website wherein the medical condition of the query is matched to a second medical condition from the plurality of medical resources").

With respect to Applicant's argument at the paragraphs bridging pages 13-15 of the 17 January 2006 amendment, that the combined applied references fail to teach or suggest displaying third information, Examiner respectfully disagrees and notes that Examiner interprets a "Web site" that is a "portal for consumers" (HealthGrades; paragraph 5) and a "Web-based site for the distribution of free health care provider ... [...] ... information" (paragraph 2) and that enables "consumers [to] find objective data regarding the best hospitals and physicians to treat their illness" (emphasis added) (HealthGrades; paragraph 5) as teaching this limitation. Examiner notes that a "portal" is "a website that aims to be an entry point to the World-Wide Web, typically offering a search engine and/or links to useful pages, and possibly news or other services. These services are usually provided for free in the hope that users will make the site

their default home page or at least visit it often. Popular examples are Yahoo and MSN. Most portals on the Internet exist to generate advertising income for their owners, others may be focused on a specific group of users and may be part of an intranet or extranet. Some may just concentrate on one particular subject, say technology or medicine;” (source: Free On-line Dictionary of Computing, URL: <<http://foldoc.org/foldoc/foldoc.cgi?portal>>).

With respect to Applicant's argument at lines 20-23 of page 14 of the 17 January 2006 amendment, that the combined applied references fail to teach or suggest means for contacting the medical resource on the website, Examiner notes that HealthGrades teaches “[t]he site will contain … [...] … online and downloadable forms, templates, tools, communications resources (e-mail and message boards) and more” (HealthGrades; paragraph 6); Examiner interprets the website containing “e-mail and message boards” to teach this limitation.

With respect to Applicant's arguments in pages 15-16 of the 17 January 2006 response, that the applied references fail to disclose recited limitations in the amended claims, these limitations have been previously addressed in this Office Action.

As per Applicant's argument at pages 17-18 of the 17 January 2006 response that the there is no motivation to combine the references and that *prima facie* obviousness has not been established, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039,

228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 09072005). Note, for example, the motivations explicitly stated at lines 17-19 of page 4 of the previous Office Action (i.e., " ... with the motivations of allowing "consumers [to] find objective data regarding the best hospitals and physicians to treat their illness," based on "collected provider data"....).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5

USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti* et al 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In addition, Examiner notes that according to *In re Kahn*, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000), *In re Kahn*, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference

which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Geller, U.S. Patent Number 6, 199, 067, Sloane, U.S. Patent Number 5, 911, 132, Turner, et al., U.S. Application Publication Number 2003/0177030 and Sloane, U.S. Patent Number 5, 619, 991 teach the environment of Internet delivery of medical information.

12. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final

action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. **Any response to this final action should be mailed to:**

14.

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please
label "PROPOSED" or "DRAFT" on the front page of
the communication and do NOT sign the
communication.

After Final communications should be labeled "Box AF."

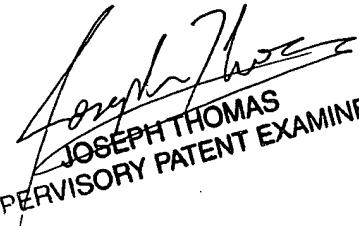
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

March 31, 2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Notice of References Cited	Application/Control No. 09/544,509	Applicant(s)/Patent Under Reexamination WYATT, PHIL	
	Examiner Natalie A. Pass	Art Unit 3626	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,199,067	03-2001	Geller, Ilya	707/10
*	B	US-5,911,132	06-1999	Sloane, Neil James Alexander	705/3
*	C	US-2003/0177030	09-2003	TURNER et al.	705/2
*	D	US-5,619,991	04-1997	Sloane, Neil J. A.	600/300
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
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FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
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NON-PATENT DOCUMENTS

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*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
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9/7/11 (Item 7 from file: 16)
DIALOG(R)File 16:Gale Group PROMT(R)

06450508 Supplier Number: 55039266 (THIS IS THE FULLTEXT)
Specialty Care Network Announces Internet Strategy; New HealthGrades.com Site to Offer Provider and Health Plan Rating Information.
Business Wire, p1519

June 30, 1999

TEXT:

LAKEWOOD, Colo.--(BW HealthWire)--June 30, 1999--
New ProviderWeb.net Site to Provide a Subscription Service for
Physician Practice Managers and Administrators
Specialty Care Network, Inc. (Nasdaq/NM:SCNI) today announced the
Internet strategy to be pursued by its majority-owned subsidiary,
HealthGrades.com, Inc. ("HealthGrades"). In August 1999 and December 1999,
HealthGrades will launch two distinct Internet sites: HealthGrades.com(TM),
a consumer-oriented site that will provide information on a variety of
healthcare providers, and ProviderWeb.net(TM), a subscription site designed
to provide Web-based tools for practice management, marketing and
communications.

Kerry R. Hicks, President and Chief Executive Officer of Specialty
Care Network, said, "These new Internet sites are the culmination of
intensive development efforts over the past ten months. They reflect our
experience in the health care industry, coupled with our traditional focus
on management information systems. We intend to make HealthGrades.com the
leading web-based site for the distribution of free health care provider
and health plan rating information. Similarly, we intend to make
ProviderWeb.net the leading web-based resource for physician practice
managers and administrators."

HealthGrades.com, is designed to provide straightforward and
objective educational quality ratings in the form of "report card"
information. The information will be based on conclusions derived from
applying complex and proprietary Company-developed algorithms to collected
provider data. Sarah Loughran, HealthGrades' Vice President - Content,
stated, "Consumers want to know two things when either they or a loved one
is ill. First, they want to know about the disease and the appropriate
procedure to treat the disease. Second, they want to know where and to whom
to go to for the best care. Many sites provide information on the former,
but only HealthGrades.com will provide information on the latter."

HealthGrades.com, Inc. currently offers Hospital Report Cards (at
www.healthcarereportcards.com), which rates virtually every U.S. hospital
based on specific performance in the areas of cardiac, orthopaedic,
neuroscience, pulmonary/respiratory and vascular care.

HealthGrades is expanding and redesigning this Web site to be a
portal for consumers to locate a wealth of information on the leading
hospitals, physicians and health plans and to make better informed health
care decisions. The expanded site, under the name HealthGrades.com, will be
relaunched in August. HealthGrades.com will include two new report card
products for physicians and health plans, as well as an expanded version of
its Hospital Report Card product that includes obstetrics and pediatrics.
Consumer sites such as AOL.com's Health & Fitness Channel (NYSE:AOL),
drkoop.com (Nasdaq:KOOP), iVillage's BetterHealth.com (Nasdaq:IVIL),
Yahoo!'s Health channel (Nasdaq:YHOO), MSN's Health channel (Nasdaq:MSFT),
Onhealth (Nasdaq:ONHN), Mediconsult (Nasdaq:MDCS), Healtheon's WebMD
(Nasdaq:HLTH), and adam.com (Nasdaq:ADAM) provide valuable disease and
condition information to consumers. However, only through HealthGrades.com
or through one of its partner sites can consumers find objective data
regarding the best hospitals and physicians to treat their illness.
Ultimately, HealthGrades.com will seek to be considered the principal
source for rating information in the health care marketplace.

ProviderWeb.net (PWN) will be a web-based subscription service for
physician practice administrators and managers. PWN is designed to take
advantage of SCN's three and one-half years of physician practice
management experience, as well as its personnel and previously developed
resources, to provide practice managers with practice management, marketing
and communication tools. The site will contain over 20 solution-based
content areas, providing online and downloadable forms, templates, tools,
communications resources (e-mail and message boards) and more. Examples of
PWN content areas are Ancillary Services, Human Resources, Payer
Contracting, Web Builder, Business Office, Finance and Accounting,
Information Systems, Marketing, Patient Satisfaction, Strategic Planning,
Reimbursement, and Training Modules. In addition to these valuable

resources, PWN intends to provide e-commerce access through links to office suppliers, medical suppliers, malpractice insurers and financial services companies, as well as online registration for seminars and conferences.

PWN will be focused exclusively on practice managers. PWN was debuted at the American Medical Group Association conference in San Francisco and is expected to launch in December 1999. SCN believes that the ProviderWeb.net site is the first site to offer comprehensive practice management tools designed to enable the practice manager to improve practice management performance.

HealthGrades.com intends to build market share and brand identity for its Web sites through content agreements with leading Internet portals and healthcare sites. To that end, HealthGrades.com is in discussions with a variety of such sites and hopes to announce new content relationships over the next several months.

The Company anticipates that hospital and health plan licenses will be the leading sources of revenue for HealthGrades.com. Medical practice subscriptions are expected to be the principal source of revenue for ProviderWeb.net. However, the Company expects both sites to derive revenue from sponsorships, e-commerce, and advertising.

Further information about HealthGrades' Web sites is available on Specialty Care Network's Web site, www.scneti.com.

This press release contains forward-looking statements, including statements concerning the projected dates of launch of the HealthGrades.com, Inc. Internet sites; the nature of the information to be provided by the Internet sites; the provision of e-commerce access through links; anticipated content agreements with Internet portals; and expected sources of revenue for the Internet sites. Actual results could differ materially from those addressed in the forward-looking statements due to: delays in development of the Internet sites caused by, among other things, technical difficulties; unavailability of certain information intended for inclusion in the sites; failure to reach agreement with Internet portals; and failure to obtain hospital and health plan licenses and medical practice subscriptions. Other risks and uncertainties are detailed in the Company's most recent Annual Report on Form 10-K and subsequent filings with the Securities and Exchange Commission.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT: Wyatt

EXAMINER: Pass

SERIAL NO.: 09/544,509

GROUP ART UNIT: 3626

FILING DATE: April 6, 2000

ATTY. DOCKET NO.:MCO-P-00-003

INVENTION: "A METHOD AND SYSTEM FOR MATCHING MEDICAL CONDITION INFORMATION WITH A MEDICAL RESOURCE ON A COMPUTER NETWORK"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

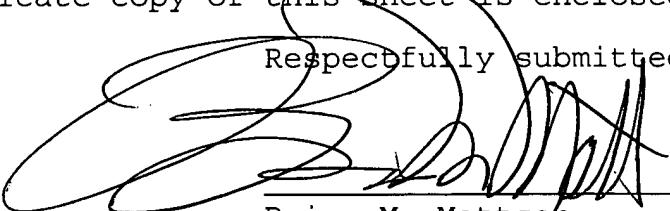
APPELLANT'S APPEAL BRIEF TRANSMITTAL LETTER

SIR/MADAM:

Appellant submits herewith Appellant's Appeal Brief in support of the Notice of Appeal filed May 26, 2006. Appellant encloses a check for \$250.00 for submission of this Appeal Brief. Appellant authorizes the Patent Office to charge any fees that may be due and owing or to credit any overpayment to Deposit Account No. 50-0595. A duplicate copy of this sheet is enclosed for this purpose.

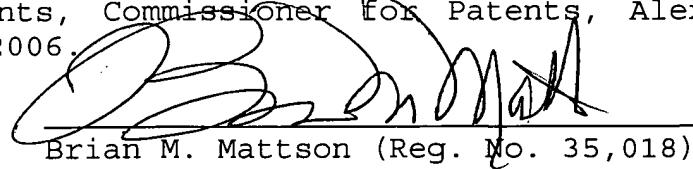
Respectfully submitted,

(Reg. No. 35,018)


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CERTIFICATE OF MAILING

I hereby certify that this APPEAL BRIEF with APPENDIX CONTAINING CLAIMS 1-20, SUPPLEMENTAL APPENDIX CONTAINING EXHIBITS A and B, EVIDENCE APPENDIX, RELATED PROCEEDINGS APPENDIX, and check for \$250.00 are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, Alexandria, VA 22313 on June 7, 2006.



Brian M. Mattson (Reg. No. 35,018)